REMARKS/ARGUMENTS

Claims 1-21 are pending in this application, of which claims 4-12 and 15-20 are currently withdrawn from consideration.

Rejections of Claims 1-3, 13-14, and 21 under 35 U.S.C. § 102(b)

Claims 1-3, 13-14, and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by Rathore et al. and Biessen et al. (WO 94/04545).

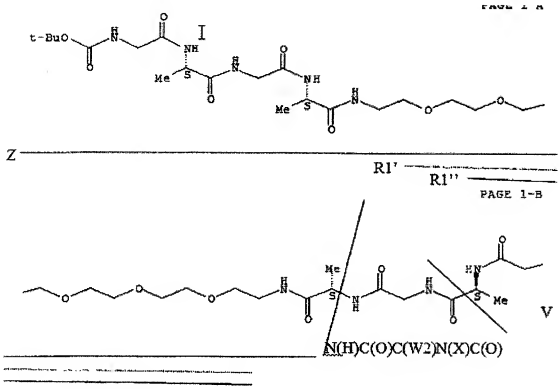
Rathore et al.

First, Applicants respectfully disagree with the Examiner that the claims are not drawn to two independent and non-overlapping occurrences of formula IIa. While Applicants agree that claims are entitled to the broadest reasonable interpretation, such broad interpretation cannot render claim terms meaningless or which ignores other claim limitations. Indeed, as indicated at page 6 of the Office Action, the Examiner counts the same residue three times in order to meet the claim limitation that the compound comprises three residues which have formula IIa (dependent claim 3). Applicants respectfully submit that counting the same residue multiple times is simply not a reasonable interpretation of the claim. For example, if a claim was directed to a composition comprising a three carbon residue, a six carbon residue, and a nine carbon residue, Applicants submit it would be improper to cite a reference as anticipatory which describes a composition consisting of a nine carbon chain because such an interpretation would ignore the limitations directed to the three carbon and six carbon residues. However, that is precisely the improper interpretation given to the pending claims by the Examiner.

Moreover, the residues of formula II(a) as claimed herein are clearly terminal residues, whereby binding takes place via the CH_2-CH_2- group, since R_1 is a terminal group selected from hydrogen, hydroxyl or a hydrocarbon residue which has from 1 to 10 carbon atoms and optionally contains heteroatoms. As no further bond is shown on R_1 and because R_1 has a defined identity which would be meaningless if further residues were permitted adjacent R1 (i.e., on the end of R_1 opposite the $(CH_2\text{-}CH_2\text{-}O)_n$ portion of the formula), formula IIa is clearly a

terminal group and not a linking group.

As explained in greater detail below, Rathore et al. does not include a compound having R_1 as claimed. The marked up compound provided by the Examiner at page 6 of the Office Action does not show R_1 as a terminal group as claimed.



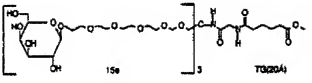
As claimed, formula (IIa) is (R_1- (CH_2-CH_2-O)$_n$-CH_2-CH_2-). Therefore, R_1 must be located adjacent (CH_2-CH_2-O)$_n$-CH_2-CH_2-). Rathore et al.'s formula 6 includes the following: Boc-GAGA-HN-(CH_2-CH_2-O)$_5$-CH_2-CH_2-NH-AGAG-Boc. Solely because of its position adjacent -(CH_2-CH_2-O)$_5$-CH_2-CH_2, the portion of Rathore et al.'s formula underlined above (Boc-GAGA-HN-) best corresponds to the portion labeled "R_1" of formula IIa. However, as defined in the pending claims, R1 is H, hydroxy or a hydrocarbon residue which has from 1 to 10 carbon atoms. As explained in more detail below, the Boc-GAGA portion of Rathore et al.'s formula has more than 1 to 10 carbon atoms. It should be noted that "Boc-GAGA" corresponds to *N*-

tert-butoxycarbonyl-Gly-Ala-Gly-Ala. Therefore, Boc-GAGA includes the 10 carbons from the two Ala "A" residues (3 carbons each, or 6 carbons combined) and two Gly "G" residues (2 carbons), as well as the 5 carbons from the "Boc" group having the following structure: $(CH_3)_3$-C-O-CO--. Therefore, Boc-GAGA provides 15 carbons, and therefore cannot meet the limitation of "where R_1 is H, hydroxy or a hydrocarbon residue which has from 1 to 10 carbon atoms" as claimed.

Accordingly, for the numerous reasons listed above, the Rathore et al. reference does not describe or suggest the claimed invention.

Biessen et al.

Next, looking to Biessen et al., the Examiner cites compound TG(20A) of Biessen et al. as being of formula 1a as claimed. The Examiner states that Z includes the repeating structural element along with a CH_2 and then provides the following figure:



Indeed, the figure above shows that the Biessen compound does not meet the claims. What the Examiner refers to as a CH_2 group indeed is only a carbon (adjacent the N-H outside of the bracketed portion) linked with the three bracketed structural elements. The Examiner states that the bracketed structural elements are repeats. Applicants respectfully disagree. Instead, Applicants respectfully submit that the formula depicts three independent occurrences of the bracketed element bonded to the same carbon atom, thus leaving that carbon atom without any hydrogen atoms. Accordingly, at best, Biessen has a O-CH_2 portion within the brackets which is adjacent the carbon outside of the brackets. Indeed, the linker shown by Biessen et al. is a formaldehyde acetal, not an ethylene oxide linker (0-CH_2-CH_2-) as found in formula IIa of the pending claims. Accordingly, the Biessen et al. compound does not meet the claims.

Accordingly, for at least the reasons discussed above, Applicants respectfully submit that Biessen et al. does not teach or suggest the claimed invention.

Double Patenting

Applicants will file a Terminal Disclaimer once the novelty and non-obviousness of the claimed invention has been acknowledged.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§ 1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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